

Masahiro KISONO, Serial No. 09/316,908  
Page 10

Dkt. 2271/59183

### REMARKS

The application has been reviewed in light of the final Office Action dated January 23, 2004. Claims 1-20 are pending in this application, with claims 1, 6 and 12 being in independent form.

By this Amendment, Applicant has amended claims 1, 6 and 12 to clarify the claimed invention, and more specifically that the facsimile image is generated in accordance with the stored information set of communication capabilities pertaining to the called data terminal, in order for the facsimile image to be acceptable to the called data terminal. The Office Action considered these features, but stated that the features are not recited in the claims (which Applicant does not concede). However, in order to facilitate examination of the claims, Applicant has amended claims 1, 6 and 12 to more clearly recite these features. Accordingly, it is respectfully submitted that no new matter and no new issues have been introduced.

Claims 1, 2, 5, 6, 8, 11, 12, 14 and 17 were rejected under 35 U.S.C. §102(e) as purportedly anticipated by U.S. Patent No. 5,828,836 to Westwick et al. Claims 1, 2, 6-8, 12-14 and 18-20 were rejected under 35 U.S.C. §102(e) as allegedly anticipated by U.S. Patent No. 6,005,677 to Suzuki. Claims 3, 4, 9, 10, 15 and 16 were rejected under 35 U.S.C. §103(a) as purportedly unpatentable over Suzuki in view of U.S. Patent No. 5,517,324 to Fite, Jr. et al.

Applicant has carefully considered the Examiner's comments and the cited art, and respectfully submits that independent claims 1, 6 and 12 are patentable over the cited art, for at least the following reasons.

This application relates to facsimile transmission operation through a LAN (local area network) to which a client data terminal and a called data terminal are connected, wherein an information transfer request is transmitted from the client data terminal to the called data terminal

Masahiro KISONO, Serial No. 09/316,908  
Page 11

Dkt. 2271/59183

which is also connected to a PSTN (public switched telephone network). Information is exchanged during facsimile communications between sending and receiving facsimile apparatuses in order for one of the apparatuses to know the statuses and capabilities of the apparatus on the other end, such that immediacy of transmission to the destination is enhanced and the likelihood of a communication error is decreased.

Moreover, according to the present application, information sets of communication capabilities of plural data terminals (including the called data terminal) on the LAN are collected on the client data terminal, and the facsimile image is generated in accordance with the information of communication capabilities of the called data terminal, in order for the facsimile image to be acceptable to the called data terminal. Thus, image conversion need not be performed at the called data terminal.

For example, independent claim 1 is directed to a method of transmitting an information transfer request from a client data terminal, which is coupled to a local area network, to a called data terminal which is coupled to the local area network and a public switched telephone network. The method comprises (i) collecting information sets of communication capabilities of a plurality of different data terminals on the local area network at an arbitrary time on the client data terminal, the different data terminals being coupled to the local area network and the public switched telephone network and including the called data terminal, and (ii) generating on the client data terminal facsimile image information by reference to one of the stored information sets of communication capabilities pertaining to the called data terminal, wherein the facsimile image is generated in accordance with the stored information set of communication capabilities pertaining to the called data terminal, in order for the facsimile image to be acceptable to the called data terminal.

Masahiro KISONO, Serial No. 09/316,908  
Page 12

Dkt. 2271/59183

The cited art fails to disclose or suggest each and every element of the claimed invention.

Westwick, as understood by Applicant, is directed to distribution of information units (such as facsimile documents, digitized voice information, still-motion video or full-motion video frame sequence) within a networked information communication system. The information units are stored locally in plural local terminals (also referred to as "controllers" in Westwick) instead of being centrally stored in a host processor. The host processor manages all information units and their movement within the system, maintains the status and location of the information units, user profiles and billing information relating to system use by each user, and performs information routing. The information units are stored in the local controller where they were received until the host processor determines that it is time for the information unit to be sent to the specified destination.

The movement of and operations on information units in Westwick are effected through control messages. A control message may be sent to communicate or request status information. In addition, a control message can include information such as the identity of the controller to which the message is directed, the size of the requested information unit and the time at which the information unit was received and stored by the controller.

Applicant finds (and the Office Action apparently acknowledges that there are) no teachings or suggestions in Westwick, however, of (i) collecting information sets of communication capabilities of a plurality of different data terminals on the local area network at an arbitrary time on the client data terminal, the different data terminals being coupled to the local area network and the public switched telephone network and including the called data terminal, and (ii) generating on the client data terminal facsimile image information by reference to one of the stored information sets of communication capabilities pertaining to the called data

Masahiro KISONO, Serial No. 09/316,908  
Page 13

Dkt. 2271/59183

terminal, wherein the facsimile image is generated in accordance with the stored information set of communication capabilities pertaining to the called data terminal, in order for the facsimile image to be acceptable to the called data terminal, as described in claim 1 as amended.

Suzuki, as understood by Applicant, is directed to a LAN communication function for a facsimile device to exchange data with a terminal of a corresponding partner through a LAN connected to an internet. The facsimile device also has a function for exchanging image information with the terminal of the corresponding partner through an exchange network (such as a general switched telephone network).

According to Suzuki, the facsimile device has a telephone conversion table which for each destination address stores a corresponding telephone number and IP address. The facsimile device transmits a facsimile to the called terminal via the LAN instead of the exchange network when a (IP) network address of the called terminal is registered in the table. Although the transmission is coded and compressed for network communication, the coding and compression is not based on communication capabilities of the destination terminal, and there is no guarantee that the facsimile is acceptable to the destination terminal. Therefore, the facsimile device must check the result of the communication to verify that the facsimile was successfully received.

Applicant does not find (and the Office Action apparently acknowledges that there are no) teachings or suggestions in Suzuki, however, of (i) collecting information sets of communication capabilities of a plurality of different data terminals on the local area network at an arbitrary time on the client data terminal, the different data terminals being coupled to the local area network and the public switched telephone network and including the called data terminal, and (ii) generating on the client data terminal facsimile image information by reference to one of the stored information sets of communication capabilities pertaining to the called data terminal,

Masahiro KISONO, Serial No. 09/316,908  
Page 14

Dkt. 2271/59183

wherein the facsimile image is generated in accordance with the stored information set of communication capabilities pertaining to the called data terminal, in order for the facsimile image to be acceptable to the called data terminal, as described in claim 1 as amended.

Fite, as understood by Applicant, is directed to increasing the compatibility of a fax machine compatible with at least one other set of fax capabilities (for example, polling for files by directory and name, inbound routing via e-mail address, multi-hop relay, relay security, and binary file transfer).

Fite does not cure the deficiencies of Westwick and Suzuki as discussed above.

Applicant simply does not find disclosure or suggestion by the cited art of a method of transmitting an information transfer request from a client data terminal, which is coupled to a local area network, to a called data terminal which is coupled to the local area network and a public switched telephone network, wherein the method includes (i) collecting information sets of communication capabilities of a plurality of different data terminals on the local area network at an arbitrary time on the client data terminal, the different data terminals being coupled to the local area network and the public switched telephone network and including the called data terminal, and (ii) generating on the client data terminal facsimile image information by reference to one of the stored information sets of communication capabilities pertaining to the called data terminal, wherein the facsimile image is generated in accordance with the stored information set of communication capabilities pertaining to the called data terminal, in order for the facsimile image to be acceptable to the called data terminal, as described in independent claim 1.

Since the cited art does not disclose or suggest each and every feature of the claimed invention, it does not render the claimed invention unpatentable.

Independent claims 6 and 12 are patentably distinct from the cited art for at least similar

Masahiro KISONO, Serial No. 09/316,908  
Page 15

Dkt. 2271/59183

reasons.

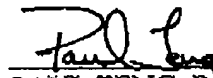
If a petition for an extension of time is required to make this response timely, this paper should be considered to be such petition, and the Commissioner is authorized to charge the requisite fees to our Deposit Account No. 03-3125.

The Office is hereby authorized to charge any additional fees that may be required in connection with this Response and to credit any overpayment to our Deposit Account No. 03-3125.

If a telephone interview could advance the prosecution of this application, the Examiner is respectfully requested to call the undersigned attorney.

Allowance of this application is respectfully requested.

Respectfully submitted,



PAUL TENG, Reg. No. 40,837  
Attorney for Applicant  
Cooper & Dunham LLP  
Tel. (212) 278-0400